



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/585,511	06/01/2000	Elliot Shmukler	S1413/7000	4873
7590	12/08/2003		EXAMINER	
R LEWIS GABLE COWAN LIEBOWITZ & LATMAN 1133 AVENUE OF THE AMERICAS NEW YORK, NY 10036-6799			BLACKWELL, JAMES H	
			ART UNIT	PAPER NUMBER
			2176	
			DATE MAILED: 12/08/2003	6

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/585,511	SHMUKLER ET AL.
	Examiner James H Blackwell	Art Unit 2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 01 June 2000.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-45 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-45 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 01 June 2000 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-3, 12-14, 23-24, and 27-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Angles et al. (hereinafter Angles, U.S. Patent No. 5,933,811).

In regard to independent Claim 1 (and similarly to independent Claim 28), Angles teaches the advertisement provider uses a consumer's member code to identify the consumer's demographic profile and preferences. The advertisement provider then selects an appropriate advertisement(s) based on the consumer's profile and sends the customized advertisement to the consumer's computer. The consumer computer then merges the content provider's electronic document with the advertisement provided by

the advertisement provider to create a single displayed document to the consumer (Col. 3, lines 56-65; compare to Claim 1 (and similarly to Claim 28), “... **(a) comparing a user's stored profile data to data regarding a plurality of items**”. **(b) identifying one or more items of interest to the user from the plurality of items according to the user's stored profile data**; **(c) organizing the identified one or more items of interest according to the user's stored profile data**; **(d) formatting a document representing the identified one or more items of interest as organized in step (c); and providing the formatted document to the user”).**

In regard to independent Claim 23, Angles teaches an advertisement database (70) (Fig. 4; compare to Claim 23, “... **a first data storage device storing item information on each item of a plurality of items for sale**”. Angles also teaches a registration module (60) and database (68) that stores demographic data as a profile in the registration database (Col. 14, lines 23-26; compare to Claim 23, “**a receiving component for receiving user purchase preference data from a client system; a second data storage device for storing the received user purchase preference data**”. Angles also teaches an advertising module (62) which uses information from the consumer profile and the content provider information to select an appropriate advertisement from the advertisement database. The advertising module then sends a customized advertisement directly to the consumer computer to be incorporated into an electronic page (32) from the content provider computer (14). Compare to Claim 23, “... **a list generating component for comparing, for each respective user, the respective user purchase preference data to the stored item information to**

***generate a list of one or more items for sale that may be of interest to the respective user; and a transmission component for transmitting the generated list to the respective user on the client system".***

In regard to dependent Claim 2 (and similarly to dependent Claim 30), Angles teaches custom advertisements that can contain hyper-links to other information (Col. 4, lines 6-7; compare to Claim 2 (and similarly to Claim 30), “***... providing one or more hyperlinks directing the user to additional information for a respective one of the one or more identified items of interest***”).

In regard to dependent Claim 3 (and similarly to dependent Claim 29), Angles teaches an advertisement provider that selects an appropriate advertisement(s) based on the consumer's profile and sends the customized advertisement to the consumer's computer. The consumer's computer then merges the content provider's electronic document with the advertisement provided by the advertisement provider to create a single displayed document to the consumer (Col. 3, lines 58-65). Angles also teaches that the communications medium over which the advertisement computer and the consumer computer communicate is the Internet, a computer network (Col. 9, lines 4-18; compare to Claim 3 (and similarly to Claim 29), “***... sending the formatted document to the user through a computer network***”).

In regard to independent Claim 12, Angles teaches a consumer who wishes to receive customized advertisements first registers (on the client computer) with the advertisement provider by entering pertinent demographic information into the advertisement provider's demographic database (Col. 3, lines 18-22; compare to Claim

12, “*... under control of a client system: (a) displaying preference information to be selected by the user*”. Angles also teaches that the advertisement provider then retains a demographic profile of the consumer (Col. 3, lines 22-24). Angles also teaches that content providers also register with the advertisement provider (first server) before they can receive the customized advertisement services (Col. 3, lines 29-31; compare to Claim 12, “*(b) upon completion of preference selection by the user, sending the selected preference information to a first server system*”; and “*under control of the first server system: (c) receiving the selected preference information; (d) storing the selected preference information*”. Angles also teaches the advertisement provider also obtains a consumer’s member code from the consumer computer. The advertisement provider uses the consumer’s demographic profile and preferences to select an appropriate advertisement based on the consumer’s profile and sends the customized advertisement to the consumer computer (Col. 3, lines 55-61; compare to Claim 12, “*(e) comparing the selected preference information to data representing one or more items available for purchase and determining one or more items of interest to the user; and (f) sending information regarding the identified one or more items of interest to the client system*”.

In regard to dependent Claim 13, Angles defines a client-server as a model of interaction in a distributed system in which a program at one site sends a request to a program on another site and waits for a response. The requesting program is called the “client”, and the program that responds to the request is called the “server”. In the context of the World Wide Web, the client is typically a “web browser” which runs on a

user's computer; the program which responds to the Web browser requests at a website is commonly referred to as a "Web server." (Col. 5, lines 62-67, Col. 6, lines 1-3; compare to Claim 13, "... ***the client system and the server system communicate with one another via a computer network***").

In regard to dependent Claim 14, Angles teaches the advertisement provider (first server) then selects an appropriate advertisement based on the consumer's profile and sends the customized advertisement to the consumer computer (client) (Col. 3, lines 58-61; compare to Claim 14, "... ***under control of the first server system: (g) formatting a document to include information regarding the determined one or more items of interest and sending the formatted document to the client system***").

In regard to dependent Claim 24, Angles teaches an electronic page module (32) within the content provider computer (14) provides an organizational structure for presenting information to the consumer. Each electronic page (32) contains an advertisement insert (56) that acts as a placeholder for the customized advertisements (Col. 12, lines 51-58; compare to Claim 24, "... ***a formatting component to order the list of one or more items and to format the ordered list in a document***").

In regard to dependent Claim 27, Angles teaches an electronic page (32) that contains an advertisement insert that acts as a placeholder for the customized advertisements (Col. 12, lines 51-58). Angles also teaches that the electronic pages (32) are HTML documents that contain HTML encoding. Angles also teaches an advertising insert containing an advertising request that is an HTML tag that identifies,

among other things, the URL of the advertisement provider's computer (Col. 13, lines 1-7; compare to Claim 27, "... **wherein the formatting component comprises: a linking component for adding a hyperlink to the document for each respective item in the list**".)

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angles in view of Levin et al. (hereinafter Levin, U.S. Patent No. 6,434,556)

In regard to dependent Claim 15, Angles fails to teach the formatted document containing a hyperlink for the respective one or more items of interest. However, Levin teaches that clicking on any of the nodes in the display tree will take the user to the web page the icon corresponds to (Col. 9, lines 37-40; compare to Claim 15, "... **the formatted document comprises a hyperlink for each respective one of more items of interest**".) Levin does not specifically teach a hyperlink associated with each item of interest. However, one of ordinary skill in the art at the time of invention would have been motivated to assume that since the teaching discusses clicking nodes, icons that

when clicked take one to a web page that the transport to a web site by clicking was facilitated by there having been a hyperlink associated with each item of interest.

In regard to dependent Claim 16, Angles teaches a merged document containing the content provider's electronic document (second server) and the advertisement provider's (first server) linked ads to create a single displayed document to the consumer (Col 3, lines 61-65); compare to Claim 16, “... ***wherein each hyperlink is directed to a second server system different from the first server system***”).

In regard to dependent Claim 17, Angles teaches an advertisement provider (first server) that selects an appropriate advertisement based on the consumer's profile (Col. 3, lines 58-61). Angles also teaches custom advertisements which can contain hyperlinks to other information (Col. 4, lines 6-7; compare to Claim 17, “... ***wherein each hyperlink is directed to information on the first server system***”). One of ordinary skill in the art at the time of invention would have been motivated by the teaching to assume that the custom advertisements' hyperlinks would have been directed to the first server system that were identified as the advertisement provider providing the benefit of having hyperlinks to information on the items of interest to the consumer be located on the advertisement web site.

5. Claims 4-5 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angles in view of Fortenberry et al. (hereinafter Fortenberry, U.S. Patent No. 6,101,485).

In regard to dependent Claim 4, Angles fails to teach sending the formatted document as an e-mail message. However, Fortenberry teaches an E-flyer that is an electronic solicitation distributed electronically via e-mail (Col. 2, lines 11-12). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Angles and Fortenberry providing the benefit of sending the formatted document as an e-mail message.

In regard to dependent Claim 5, Angles fails to teach sending the e-mail message via a computer network. However, Fortenberry teaches that on the Internet (computer network), e-commerce sites can be accessed directly through an e-catalog (Col. 1, lines 28-31). Fortenberry also teaches that the e-commerce site catalog can take the form of a solicitation sent to shoppers via e-mail (Col. 1, lines 44-46; compare to Claim 5, “*... sending the e-mail message via a computer network*”). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Angles and Fortenberry providing the benefit of sending the e-mail message via a computer network.

In regard to dependent Claim 25, Angles fails to teach a transmission component transmitting the document as an e-mail sent via a computer network. However, Fortenberry teaches an E-flyer that is an electronic solicitation distributed electronically via e-mail, acquired from web sites or sent on a channel using push technologies (Col. 2, lines 11-13; compare to Claim 25, “*... wherein the transmission component transmits the document as an e-mail sent via a computer network*”). Fortenberry does not explicitly teach that the e-mail is sent via a computer network. However, one

of ordinary skill in the art at the time of invention would have been motivated to assume a computer network was involved since distributing things electronically or using push technologies were inherently related to computer networks providing the benefit of transmitting e-mail over a network.

6. Claims 6, 18-19, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angles in view of Pirolli et al. (hereinafter Pirolli, U.S. Patent No. 6,272,507).

In regard to dependent Claim 6 (and similarly to dependent Claim 31), Angles fails to teach ordering the items of interest from highest to lowest interest as a function of the user's stored profile. However, Pirolli teaches ordering and ranking of search results (lists of hyperlinks to web sites) from high interest to lower interest based on a number of criteria such as similarity to a user's query, proximity of search terms, etc. (Col. 2, lines 1-6; compare to Claim 6 (and similarly to Claim 31), ***“... ordering the identified one or more items of interest in an order from highest interest to lowest interest as a function of the user’s stored profile data”***). One of ordinary skill in the art at the time of invention would have been motivated to order selected items on a page from highest to lowest interest based on a user profile since this provided a way to see the items most interesting to the user as he or she would have requested seeing them providing the benefit of viewing favorite items first.

In regard to dependent Claim 18, Angles fails to teach ordering the items of interest from highest to lowest based on a customer's preferences. However, Pirolli teaches ordering and ranking of search results (lists of hyperlinks to web sites) from

high interest to lower interest based on a number of criteria such as similarity to a user's query, proximity of search terms, etc. (Col. 2, lines 1-6; compare to Claim 18, "... (g) ***ordering the determined one or more items of interest in an order from highest interest to lowest interest as a function of the user's stored selected preference information***"). Pirolli does not explicitly teach ordering as a function of the user's stored selected preference information. However, one of ordinary skill in the art at the time of invention would have been motivated to combine these teachings because what the customer would have received as their customized advertisement would have been based on what was stored in the advertisement provider's database and that data would have forced a certain ordering on the ads that were selected having the most popular being placed at the top of the ranking followed by the rest in order of their relevance to the customer's demographics. The benefit would have been to receive a listing of items ranked according to interest of the customer

In regard to dependent Claim 19, Angles teaches the advertisement provider (first server) then selects an appropriate advertisement based on the consumer's profile and sends the customized advertisement to the consumer computer (client) (Col. 3, lines 58-61). Angles fails to teach the ordering as established in step (g). However, Pirolli teaches ordering and ranking of search results (lists of hyperlinks to web sites) from high interest to lower interest based on a number of criteria such as similarity to a user's query, proximity of search terms, etc. (Col. 2, lines 1-6; compare to Claim 19, "... ***under the control of the first server system: (h) formatting a document to include information regarding the determined one or more items of interest in the order***

***established in step (g) and sending the formatted document to the client system".***

One of ordinary skill in the art at the time of invention would have been motivated to combine the teachings of Angles and Pirolli providing document formatting that included information regarding the determined one or more items of interest in an order established in step (g) providing the benefit of a document in which the highest interest items appeared at the top of the document.

7. Claims 7, 9, 20-22, 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angles in view of Pirolli and in further view of Levin.

In regard to dependent Claim 7 (and similarly to dependent Claim 32), Angles fails to teach placing a predetermined number of the one or more items of interest in a top portion of the formatted document. However, Levin teaches a display space relevance profile where interest in a given site is depicted from the upper left (highest rank) to the lower right (lowest rank) of the results page (Col. 6, lines 57-60; compare to Claim 7 (and similarly to Claim 32), ***“... placing a predetermined number of the one or more items with the highest interest in a top portion of the formatted document”***). Levin does not specifically teach that the highest interest items get placed at the top of the formatted document. However, one of ordinary skill in the art at the time of invention would have been motivated to combine the teachings of Angles Pirolli and Levin providing the benefit of having the item with the highest interest located at the upper left of the display space albeit in the leftmost part of the display.

In regard to dependent Claim 9 (and similarly to dependent Claim 33), Angles fails to teach providing a hyperlink and image for each respective item of the predetermined number of items placed in the top portion of the formatted document. However, Levin teaches icons that can take the place of rectangular boxes. The icons are selected based on the root node (Col. 6, lines 27-31). Levin also teaches that clicking on any of the nodes in the display tree will take the user to the web page the icon corresponds to (Col. 9, lines 37-40; compare to Claim 9 (and similarly to Claim 33), ***“... providing a hyperlink and image for each respective item of the predetermined number of items placed in the top portion of the formatted document”***). One of ordinary skill in the art at the time of invention would have been motivated to combine the teachings of Angles, Pirolli and Levin providing the benefit of linking to the most favored items.

In regard to dependent Claim 20, Angles fails to teach inserting a hyperlink for each respective one or more items of interest in the formatted document, wherein each hyperlink points to additional information about the respective one or more items of interest. However, Levin teaches icons that can take the place of rectangular boxes. The icons are selected based on the root node (Col. 6, lines 27-31). Levin also teaches that clicking on any of the nodes in the display tree will take the user to the web page the icon corresponds to (Col. 9, lines 37-40; compare to Claim 20, ***“... step (h) comprises: (i) inserting a hyperlink for each respective one or more items of interest in the formatted document, wherein each hyperlink points to additional information about the respective one or more items of interest”***). Levin does not

specifically teach inserting a hyperlink for each of the items of interest pointing to additional information. However, one of ordinary skill in the art at the time of invention would have been motivated to assume that hyperlinks were involved because the act of clicking on an icon took one to a web page, and a common mechanism by which one clicks and is then transported to a web site was through the use of a hyperlink providing the benefit of linking to additional information on a web site.

In regard to dependent Claim 21, Angles fails to teach placing the hyperlink for a predetermined number of the one or more items of interest in a top portion of the formatted document. However, Levin teaches a display space relevance profile where interest in a given site is depicted from the upper left (highest rank) to the lower right (lowest rank) of the results page (Col. 6, lines 57-60). Levin also teaches that clicking on any of the nodes in the display tree will take the user to the web page the icon corresponds to (Col. 9, lines 37-40; compare to Claim 21, “*... (j) placing the hyperlink for a predetermined number of the one or more items of interest in a top portion of the formatted document*”). Levin does not specifically teach placing a hyperlink for the predetermined number of the items of interest in a top portion of the formatted document. However, one of ordinary skill in the art at the time of invention would have been motivated to assume that a predetermined number of the one or more items of interest depicted those of highest interest and therefore from the teaching, would have been placed at the top of the document. The act of clicking on a node resulting in having been transported to a web site was well known in the art at the time of invention as having been facilitated by the use of a hyperlink providing the benefit of taking one to

the web site associated with the predetermined number of the one or more items of interest.

In regard to dependent Claim 22, Angles fails to teach providing a graphic image in the respective hyperlink of the predetermined number of one or more items of interest placed in the top portion of the formatted document. However, Levin teaches icons that can take the place of rectangular boxes. The icons are selected based on the root node (Col. 6, lines 27-31). Levin also teaches that clicking on any of the nodes in the display tree will take the user to the web page the icon corresponds to (Col. 9, lines 37-40; compare to Claim 22, “*... (k) providing a graphic image in the respective hyperlink of the predetermined number of one or more items of interest placed in the top portion of the formatted document*”). Levin does not specifically teach a graphic image. However, one of ordinary skill in the art at the time of invention would have been motivated to assume that icons are a type of graphical image and usually have represented scaled down versions of the one or more items of interest.

8. Claim 10, 11 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angles in view of Pirolli and in further view of Levin and in further view of Fortenberry.

In regard to dependent Claim 10 (and similarly dependent Claim 26), Angles fails to teach that the formatted document is an HTML document. However, Fortenberry teaches that an E-flyer is an HTML document (Col. 3, line 46; compare to Claim 10 (and similarly to Claim 26), “*... the formatted document is an HTML document*”).

Fortenberry does not explicitly teach that an E-flyer is a formatted document. However, one of ordinary skill in the art at the time of invention would have been motivated to assume that an E-flyer, given the teaching that it was an HTML document, was formatted. It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Angles, Pirolli, Levin and Fortenberry providing the benefit of a formatted HTML document.

In regard to dependent Claim 11, Angles fails to teach a predetermined number is not greater than three. However, Levin teaches the scaling of each site tree depending on the number of sites returned and the size of the display (Col. 12, lines 15-23; compare to Claim 11, “... ***the predetermined number is not greater than three***”. Levin does not specifically teach that the predetermined number is not greater than three. However, one of ordinary skill in the art at the time of invention would have been motivated to choose such a number if the size of the display was small enough that more than three would not have fit on the display. The benefit would have been to enable one to see all of the items at one viewing.

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Angles in view of Pirolli and in further view of Levin and in further view of Brown et al. (hereinafter Brown, U.S. Patent No. 6,646,659).

In regard to dependent Claim 8, Angles fails to teach grouping the one or more items not in the predetermined number of items placed in the top portion of the formatted document by categories; and ordering the categories from the highest interest

to lowest interest as a function of the user's stored profile data. However, Brown teaches food menu items that are displayed, but those food menu items that are not selected are indicated by a flag (Col. 5, lines 42-43). Brown also teaches food menu items that are displayed in a sequential format where the best selection is displayed first and the worst selected displayed last (Col. 5, lines 44-46). Compare to Claim 8, “... ***grouping the one or more items not in the predetermined number of items placed in the top portion of the formatted document by categories; and ordering the categories from the highest interest to lowest interest as a function of the user's stored profile data***”. Brown does not specifically teach grouping items by categories. However, it would have been obvious to one of ordinary skill in the art at the time of invention to have been motivated to combine the teachings of Brown providing the benefit of selecting foods in a user-friendly manner.

10. Claims 34-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fortenberry.

In regard to independent Claim 34 (and similarly independent Claims 38 and 42), Fortenberry teaches that an E-flyer's creation targeting a specific user is made possible through the acquisition and analysis of shopper data. Shopper data can be acquired either by shopper responses using fill-in forms such as during a registration process or during visits to an e-commerce site where that user is known, having logged in with a user id or by responding to an e-flyer. Fortenberry also teaches that while at the e-commerce site, shopper behaviors can be logged and later categorized and stored at

the e-commerce site. Shoppers may also explicitly state preferences in forms provided at the e-commerce site (Col. 4, lines 13-24; compare to Claim 34 (and similarly to Claims 38 and 42), “*... retrieving a profile associated with a first individual*”.

Fortenberry does not explicitly teach retrieving a profile. However, one of ordinary skill in the art at the time of invention would have been motivated by the teaching to have used shopper data since it contained an abundance and variety of information on the customer to which the E-flyer was targeted to. Claim 34 (and similarly Claims 38 and 42) further cites, “*... identifying a newsletter template in the retrieved profile, said newsletter template having one or more variable fields each to be provided with data as a function of information in the retrieved profile; identifying an email address in the retrieved profile*”. Since Fortenberry teaches a variety of means for obtaining data on customers, and hence a variety of data on those customers, one of ordinary skill in the art at the time of invention would be motivated to assume that a newsletter template as well as other data targeting a specific customer or group of customers would be contained in a retrieved profile. Claim 34 (and similarly Claims 38 and 42) further cites, “*... establishing a connection with a mail server associated with the identified e-mail address*”. Fortenberry teaches E-flyers can be distributed electronically to shoppers in a number of ways including e-mail (Col. 4, lines 38-41). Fortenberry does not explicitly teach establishing a connection with a mail server. However, one of ordinary skill in the art at the time of invention would have been motivated to establish a connection with a mail server in the normal process of sending an e-mail electronically providing the benefit of getting an e-mail sent. Claim 34 (and

similarly Claims 38 and 42) further cite, “*... sending the newsletter template to the mail server, and, if, as the newsletter template is being sent to the mail server, a variable field is encountered, providing the data for the variable field as a function of information in the retrieved field; and continuing to send the newsletter template, wherein the newsletter template with its one or more variable fields each completed with provided data is sent to the identified e-mail address*”.

Fortenberry teaches automatic E-flyer construction that is created by software algorithms that select the E-flyer content. The content may be general or specifically tailored to the intended recipient's preferences. Fortenberry does not specifically teach variable fields in a newsletter template that are populated during the sending of the template to the e-mail server. However, Fortenberry does teach by example a scenario whereby a shopper states in their preferences a desire to receive an E-flyer about a specific product on a periodic basis. When conditions are right, an E-flyer is automatically generated and sent to the mail server (Col. 4, lines 26-35). One of ordinary skill in the art at the time of invention would have been motivated to assume that the automatic process of constructing the E-flyer and sending it to a mail server would include a step whereby variable fields in the E-flyer template would have been populated with the appropriate content providing the benefit of a complete E-flyer sent to the customer. Claim 34 (and similarly Claims 38 and 42) further cite, “*... and wherein no version of the newsletter template with one or more variable fields completed is stored other than on the mail server*”. One of ordinary skill in the art at the time of invention would have been motivated to assume that once customized as

described above, an E-flyer would have been useful only to its recipient and no one else and would have therefore only remained on the mail server to which it was sent.

In regard to dependent Claim 35 (and similarly Claims 39 and 43), Fortenberry teaches an E-flyer that is an HTML document whose creation is facilitated by a software utility designed to construct E-flyer documents (Col. 3, line 46; lines 60-63; compare to Claim 35 (and similarly Claims 39 and 43), “... ***wherein the newsletter template is an HTML document***”). Fortenberry does not specifically teach a newsletter template. However, one of ordinary skill in the art at the time of invention would have been motivated to assume that a template was involved in the construction of the E-flyer using the utility software providing the benefit of knowing where to place advertisements in the E-flyer.

In regard to dependent Claim 36 (and similarly Claims 40 and 44), Fortenberry teaches an E-flyer that is an HTML document whose creation is facilitated by a software utility designed to construct E-flyer documents (Col. 3, line 46; lines 60-63 compare to Claim 36 (and similarly to Claims 40 and 44), “... ***wherein the newsletter template is a text document***”). Fortenberry does not explicitly teach a text document. However, one of ordinary skill in the art at the time of invention would have been motivated to assume that the taught HTML document is text based rather than, for example, a binary file. The benefit of having a text-based document would have been to allow for easy editing by a simple text editor.

In regard to dependent Claim 37 (and similarly Claims 41 and 45), Fortenberry teaches an E-flyer that identifies product names, descriptions and prices and contains

control features to link the shopper directly to the e-commerce site. Control features include, for example, a search utility, delivery request, shop at e-commerce site request and customer service link (Col. 3, lines 49-54; compare to Claim 36 (and similarly to Claims 41 and 45), “... **wherein at least one of the variable fields in the newsletter template is provided with data that is a Uniform Resource Locator (URL) link**”. Fortenberry does not explicitly teach a URL link, however Fortenberry does teach that an E-flyer is an HTML document whose construction is aided by a software utility (Col. 3, lines 46; lines 60-63). One of ordinary skill in the art at the time of invention would have been motivated to assume that the taught link is a URL because the E-flyer was an HTML document and HTML documents can contain links that are URLs.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Templeman	U.S. Patent No. 5,845,303	issued	12/1998
Carlin et al.	U.S. Patent No. 6,119,152	issued	09/2000
Bernardo et al.	U.S. Patent No. 6,219,680	issued	04/2001
Nye	U.S. Patent No. 6,578,043	issued	06/2003
Egendorf	U.S. Patent No. 5,794,221	issued	08/1998
Cremin	U.S. Patent No. 6,477,704	issued	11/2002
Manohar et al.	U.S. Patent No. 6,572,662	issued	06/2003

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Blackwell whose telephone number is 703-305-0940. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on 703-305-9792. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

James Blackwell  
12/01/03



JOSEPH H. FEILD  
PRIMARY EXAMINER